



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,797	12/29/2000	Laure Dumoutier	LUD-5543.3 CONT.	5783
24972	7590	10/21/2005	EXAMINER	
FULBRIGHT & JAWORSKI, LLP				GAMBEL, PHILLIP
666 FIFTH AVE				ART UNIT
NEW YORK, NY 10103-3198				PAPER NUMBER
				1644

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/751,797	DUMOUTIER ET AL.
	Examiner	Art Unit
	Phillip Gambel	1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 September 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,4,7,8,10,11,14-16,18,19 and 50-56 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 53-56 is/are allowed.
 6) Claim(s) 1,3,4,7,8,10,11,14-16,18, 19, 50-52 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment, filed 9/7/05, has been entered.

Claim 15 has been amended.

Claims 1, 3, 4, 7, 8, 10-11, 14-16, 18-19 and 50 - 56 are pending.

Claims 2, 5, 6, 9, 12-13, 17 and 20-49 have been canceled previously.

As indicated previously, claims 53-56 appear to be free of the prior art.

2. The text of those sections of Title 35 USC not included in this Action can be found in a prior Action.

Applicant's statement that the Brief on Appeal raise new arguments not addressed by the examiner is acknowledged.

Applicant is invited to provide guidance as to those new arguments presented in the Brief on Appeal, filed 6/22/05.

However as pointed out previously, applicant's arguments set forth in the Brief on Appeal, filed 6/22/05, and the examiner's rebuttal are essentially the same of record, at least, to the examiner.

The rejections of record can be found in the previous Office Actions.

See the previous Office Actions for a more complete analysis of applicant's arguments and the examiner's rebuttal.

Applicant's arguments have not been found persuasive.

3. Claims 1, 3, 4, 7, 8, 10, 11, 14-16, 18, 19 and 50-52 stand rejected under 35 U.S.C. 112, first paragraph, because the specification,

while enabling for isolated nucleic acids which encode a T cell inducible factor which is a protein and which activates STAT3, which consists of SEQ ID NO: 7, SEQ ID NO: 8, SEQ ID NO: 24 and SEQ ID NO: 25 (and vectors, recombinant cells comprising said nucleic acids)

does not reasonably providing enablement for the broader recitation of

nucleic acids which encode a T cell inducible factor which is a protein and which activates STAT3, the complementary sequence of which hybridizes under the claimed stringent conditions to at least one of SEQ ID NO: 7, SEQ ID NO: 8, SEQ ID NO: 24 and SEQ ID NO: 25 (and vectors, recombinant cells comprising said nucleic acids) essentially for the reasons of record.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant's assertions / arguments and the examiner's rebuttal are essentially the same of record.

Applicant's arguments have not been found persuasive.

Art Unit: 1644

4. Claims 1, 3, 4, 7, 8, 10, 11, 14-16, 18, 19 and 50-52 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons of record.

For example, the specification discloses a diversity of structure and function of the disclosed T cell inducible factors encoded by nucleic acid molecules consisting of SEQ ID NO: 7, SEQ ID NO: 8, SEQ ID NO: 24 and SEQ ID NO: 25.

The specification discloses SEQ ID NOS: 7, 8, 24 and 25 which corresponds to the cDNA encoding the human and mouse species of T cell derived inducible factors. SEQ ID NOS: 7, 8, 24 and 25 meet the written description provisions of 35 USC 112, first paragraph.

However, the instant claims to nucleic acids that encode T cell inducible factors, which encompass "genomic sequences" from "all mammalian species". The claimed nucleic acids encompass genomic sequences, sequences that hybridize to SEQ ID NOS: 7, 8, 24 and 25, corresponding sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have a recited degree of identity (similarity, homology), and so forth. Nucleic acid sequences other than SEQ ID NOS. 7, 8, 24 and 25 do not meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant's assertions / arguments and the examiner's rebuttal are essentially the same of record.
Applicant's arguments have not been found persuasive.

5. Applicant's amended claim 15, filed 9/7/05, has obviated the previous rejection under 35 U.S.C. § 112, second paragraph.
6. The terminal disclaimer filed on 9/7/05, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USSN 10/206,274 been reviewed and is accepted. The terminal disclaimer has been recorded.
7. Claims 53-56 appear to be free of the prior art.
Accordingly, claims 53-56 are deemed allowable.

Art Unit: 1644

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (571) 272-0844. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
October 17, 2005